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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/148,723	09/03/1998	WARREN M. FARNWORTH	MI22-981	3884

21567 7590 12/16/2003
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SPOKANE, WA 99201

EXAMINER	
TUGBANG, ANTHONY D	
ART UNIT	PAPER NUMBER
3729	<i>45</i>

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/148,723	FARNWORTH ET AL.
	Examiner A. Dexter Tugbang	Art Unit 3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 September 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,6,8,11,13,20,22,23,26,27,30,31,36,37,45 and 48-53 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1,2,23,26,27,30,31,36,37,45 and 48-53 is/are allowed.
- 6) Claim(s) 3,6,8,11,13,20 and 22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>41</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Amendment

1. The applicants' amendment filed 9/18/03 (Paper No. 43) has been fully considered and made of record.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 3, 6, 8, 11, 13, 20 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 6, 8, 11, 12, 18 and 20 of copending Application No. 10/004,172 in view of PCT Publication WO 98/12738, referred to hereinafter as WO'738.

Regarding Claims 3, 6, 8 and 11 of the instant application, these limitations are met substantially by the limitations of Claims 12, 6, 8 and 11 of copending Application No. 10/004,172 with the exception of the absence of flux when bonding the balls.

Regarding Claims 13, 20 and 22 of the instant application, these limitations are met substantially by the limitations of Claims 18 and 20 of copending Application No. 10/004,172

with the exception of the absence of flux when bonding the balls and moving the frame to proximate the substrate before any of the of balls are delivered into the holes.

WO'738 teaches a bonding process including: 1) providing both a fluxless bonding surface, i.e. the absence of flux (see page 5); and 2) moving a frame 18 (in Fig. 1) with a plurality of holes 22 to proximate a substrate 10 before any balls 24 are delivered into the holes 22. The benefits of the above bonding process accurately place the balls of solder on the substrate through the use of the frame and effect bonding conditions within a continuous manufacturing process at various stations (as shown in Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the claims of copending Application No. 09/148,723 by utilizing the bonding process taught by WO'738, to advantageously provide the benefits of placing the balls of solder on the substrate through the use of the frame and effect bonding conditions within a continuous manufacturing process at various stations.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

4. Applicant's arguments filed 9/18/03 (Paper No. 43) have been fully considered but they are not persuasive.

The applicants' believe that the Double Patent rejection above is inappropriate because of the Restriction Requirement issued in the instant application (Paper No. 5).

The examiner most respectfully disagrees. The applicants' are correct in noting that Application Ser. No. 10/004,172 is a divisional application of the instant application. However,

the divisional application is not a result of the restriction requirement set forth in Paper No. 5 of the instant application. Paper No. 5 invokes a restriction requirement between two distinct inventions of 1) a process of making, and 2) an apparatus. While the claims of the instant application are directed to the process of making, the claims of the divisional application are not directed to apparatus claims, which is what the result should have been in a divisional application based on the restriction requirement in Paper No. 5. The claims of the divisional application are directed to similar process of making claims. Accordingly, the examiner maintains the provisional double patenting rejection above.

Allowable Subject Matter

5. Claims 1, 2, 23, 26, 27, 30, 31, 36, 37, 45 and 48-53 are allowed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



A. Dexter Tugbang
Primary Examiner
Art Unit 3729

December 15, 2003